

REMARKS/ARGUMENTS

Claims 1-21 are present in this application. By this Amendment, claim 10 has been amended. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Claims 10, 12 and 13 were rejected under 35 U.S.C. §103(a) over U.S. Published Patent Application No. 2003/0181302 to Kaiser et al. or, in the alternative, under 35 U.S.C. §103(a) over Kaiser in view of “Applicants’ Admitted Prior Art” (AAPA). This rejection is respectfully traversed.

In the grounds of rejection, the Examiner maintains the improper assumption that since Kaiser is silent with regard to particle components of its clay, it follows that the clay has no particle components. The Office Action again suggests that the clay in Kaiser includes 0% particle components. As discussed in the Amendment filed February 27, 2007, Applicants respectfully submit that this characterization of the Kaiser publication is technically inaccurate. The February 27 remarks in this regard are hereby reasserted.

The Office Action provides that “[i]n the alternative, if applicant believes that Kaiser et al. do not teach clay having no particle components, the Examiner considers the Applicant’s disclosure (page 1, third paragraph, under Remarks/Arguments filed 2/27/2007) as admitted prior art, wherein the Applicant submits that clay naturally contains particle component.” The Examiner then concludes that it would have been obvious to provide the invention of Kaiser “with clay having naturally occurring particle components as taught by AAPA, in order to provide a disc roll comprised of desired and suitable material content.” Applicants respectfully disagree with this conclusion.

Applicants agree that clay naturally contains particle components. It is improper hindsight, however, to reach the conclusion in the Office Action that this fact meets or suggests the specific structure defined in claim 10. Neither Kaiser nor the AAPA even remotely discloses disc members that comprise an inorganic fiber, mica and a clay having a content of particles with a particle size of 5 µm or larger of not higher than 30% by weight based on the weight of the clay. Claim 10 has been amended for clarity to reference “a content of particles.” Naturally occurring particle components in typical clay do not meet these criteria, and nothing in Kaiser or the AAPA suggests that this structure is known. The advantages and effects of this structure are described and demonstrated in the specification (e.g., see also Table 1B on page 32). See also the Remarks in the February 27 Amendment.

Applicants thus respectfully submit that the hindsight conclusion in the Office Action is improper, and withdrawal of the rejection is requested.

With regard to dependent claims 12, 13 and 20,* Applicants submit that these claims are allowable at least by virtue of their dependency on an allowable independent claim.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 11 was rejected under 35 U.S.C. §103(a) over Kaiser in view of AAPA and U.S. Patent No. 4,533,581 to Asaumi et al. The Asaumi patent, however, does not correct the deficiencies noted above with regard to Kaiser and AAPA, taken singly or in combination. That is, neither reference nor the AAPA provides any suggestion to modify the Kaiser discs to include the claimed materials. As such, Applicants submit that this dependent claim is allowable at least

* Although claim 20 is not listed in the statement of the rejection, the Office Action references claim 20 in the grounds of rejection in the paragraph bridging pages 3 and 4 of the Office Action.

by virtue of its dependency on an allowable independent claim. Withdrawal of the rejection is requested.

Claim 21 was rejected under 35 U.S.C. §102(e) over Kaiser or, in the alternative, under 35 U.S.C. §103(a) over Kaiser in view of AAPA. This rejection is respectfully traversed.

In the grounds of rejection, the Office Action appears to merely repeat the grounds from the rejection of claim 10. Claim 21, however, does not define the same structure, and reference to such structure in rejecting claim 21 is of no consequence. Claim 21 rather recites, among other things, that the disc members comprise an inorganic fiber, mica and a clay, the clay being either elutriated or subjected to a wet sizing separation purification process. In this context, the Office Action disregards this structure of the invention, contending that “the patentability of the product does not depend on its method of production.” Applicants do not disagree with this statement; however, Applicants submit that claim 21 defines specific structure that is lacking in the references of record. Indeed, clay having been elutriated or subjected to a wet sizing separation purification process is structurally different from clay that has not been subjected to such procedures. As such, the clay defined in claim 21 has structural features that are distinguishable from Kaiser and the AAPA. As such, Applicants submit that the rejection is misplaced.

Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the claims are patentable over the art of record and that the application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in condition for allowance, the Examiner is invited to contact Applicants’ undersigned attorney at the telephone number listed below.

NAKAYAMA et al.
Appl. No. 10/812,304
August 10, 2007

Prompt passage to issuance is earnestly solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: /Alan M. Kagen/
Alan M. Kagen
Reg. No. 36,178

AMK:jls
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100